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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/735,753 | 12/16/2003 | Kenji Kitabatake | 00684.003562. | 3353 |
| 5514 | 7590 | 06/21/2005 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | TRAN, HUAN HUU | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2861 | |

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|-------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/735,753 | KITABATAKE ET AL. | |
| | Examiner | Art Unit | |
| | Huan H. Tran | 2861 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 3, 4, 5, 6, 12, and 13 is/are rejected.
- 7) ☒ Claim(s) 7-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 12/12/2003. It is noted, however, that applicant has not filed a certified copy of the foreign priority application as required by 35 U.S.C. 119(b).

Drawings

2. The drawings were received on 04/16/04. These drawings are approved.

Claim Objections

Claim 11 is objected to because of the following informalities: " a prim" should be changed to " a prism" and " wherein are reflecting surface of the prism" should be corrected to " wherein the reflecting surface of the prism" .

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 3, 4, 5, 6, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinada et al in view of Ota et al (US Patent No. 5737300).

As to claims 1 and 5, Shinada et al discloses aaining ink, which is detachably ovision of an optical medium (32) to h the information is See Col. 15, lines 25-30.

As to claim 13, Shinada et al discloses a recording apparatus comprising the claimed liquid container (8) and writing and reading means for the optical medium of said liquid container. See Col. 15, lines 24-30.

Thus, Shinada et al discloses essentially the claimed invention except that it does not specify that the writing is performed using visible light from a semi-conductor laser beam.

However, it is submitted that the use a semi-conductor laser beam operating in the visible spectrum for writing is taught by Ota et al. See Col. 3, lines 3-25.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use visible light of a semi-conductor laser beam as taught by Ota et al to perform the writing on the optical medium provided on the liquid container taught by Shinada et al for the advantage of semi-conductor laser beam discussed in Ota et al.

With respect to claims 3, 4, 6, it is submitted that the limitations relating to the information are not given patentable weight for the reason that the information is not recited to be a positive limitation in base claim 1. The information is to be written to or read from the optical medium.

With respect to claim 4, it is shown in Fig. 1 of Shinada et al that the liquid container (8) is mountable to the carriage in a direction substantially perpendicular to a direction of movement of the carriage (1).

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shinada et al modified by Ota et al as applied to claim 1 above, and further in view of Arthur et al (US Patent No 5049898).

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Allowable Subject Matter

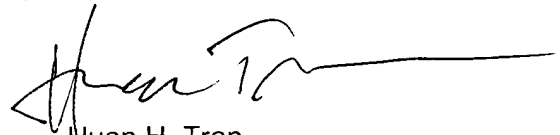
6. Claims 7, 8 9, 10, 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huan H. Tran whose telephone number is (571) 272-2261. The examiner can normally be reached on at work on W-F from 6:30 to 5; T are telework days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Talbott can be reached on (571) 272-1934. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Huan H. Tran', with a long horizontal line extending to the right.

Huan H. Tran

Primary Examiner

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hht

06/17/05